

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

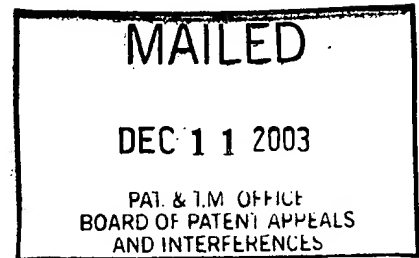
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte G. GARY GOCHANOUR

Appeal No. 2002-1123
Application No. 09/110,987

ON BRIEF



Before TIMM, DELMENDO, and JEFFREY T. SMITH, Administrative
Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 3, 5, 6, and 8 (final Office action mailed Mar. 30, 2001, paper 13) in the above-identified application. Claims 7, 9, 10, 13, 14, and 17, which are the only other pending claims, are either objected to as being dependent on a rejected base claim (claims

7 and 9) or withdrawn from further consideration pursuant to 37 CFR § 1.142(b) (1959) (claims 10, 13, 14, and 17).

The subject matter on appeal relates to a dispenser for a roll of flexible stretchable film to be used as a hand covering. Further details of this appealed subject matter are recited in representative claim 1 reproduced below:

1. A dispenser for a roll of flexible stretchable film to be used as a hand covering, the roll of film defining a central axis, and having first and second surfaces, with the first surface including an applied adhesive, the dispenser comprising:
a housing to receive the roll of film;
an edge operative to separate the film drawn off the roll into individual sheets for use; and
a base member between the roll and the edge over which the film is drawn, with the first surface facing outwardly, and wherein the base member defines an area of at least 40 square inches to permit placement of the palmar surface of an average adult human hand thereagainst to be covered by the flexible, stretchable film.

The examiner relies on the following prior art references as evidence of unpatentability:

Stoller	3,229,875	Jan. 18, 1966
Garr	4,607,774	Aug. 26, 1986

Claims 3 and 8 on appeal stand rejected under the second paragraph of 35 U.S.C. § 112 as indefinite. (Examiner's answer mailed Nov. 1, 2001, paper 18, page 3.) Further, claims 1 through 3, 5, 6, and 8 on appeal stand rejected under 35 U.S.C.

§ 103(a) as unpatentable over Garr in view of Stoller. (Id. at pages 3-4.)

We affirm both rejections.¹

35 U.S.C. § 112, ¶2: Claims 3 and 8

The examiner held that appealed claims 3 and 8 are indefinite because "[i]t is unclear how defining the workpiece (flexible film) defines the claimed invention of a rolled material dispenser assembly." (Answer, page 3; final Office action, page 2.)

The appellant has not responded to the examiner's rejection. Accordingly, we affirm this uncontested rejection.

35 U.S.C. § 103(a): Claims 1-3, 5, 6, and 8

It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application must be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d

¹ The appellant submits: "For purposes of this appeal brief, claims 2, 3, 5, 6 and 8 stand or fall with claim 1." (Second appeal brief filed Aug. 29, 2001, paper 17, p. 3.) Accordingly, we confine our discussion of the 35 U.S.C. § 103(a) rejection to claim 1. 37 CFR § 1.192(c)(7)(2001); In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'") (quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

In the present case, appealed claim 1 recites: "wherein the base member defines an area of at least 40 square inches to permit placement of the palmar surface of an average adult human hand thereagainst to be covered by the flexible, stretchable film."² Although the claim requires the base member to define an area of at least 40 square inches, it does not recite any limitation with respect to whether the defined area of the base member must accommodate the entire palmar surface of an "average

² We note that the "at least 40 square inches" limitation was inserted by amendment after the filing of the present application. (37 CFR § 1.111 (2000) amendment filed Jan. 24, 2000, paper 8.) In the event of continued prosecution, the examiner should consider whether the amended claim complies with the written description requirement of 35 U.S.C. § 112, ¶1. Cf. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (holding that "at least 35%" was not described in a foreign priority document disclosing "25-60%").

adult human hand." Nor does it contain any limitation on how the palmar surface of the hand must be oriented on the defined area of the base member. Absent any description in the specification to the contrary, we construe the recitation to require a base member that must define an area of at least 40 square inches but does not have to accommodate the entire palmar surface of an "average adult human hand."³

Garr describes a wrapping table assembly including a dispenser for a roll of plastic film that may be used for wrapping food products comprising a housing to receive the roll of film (13, 14, 27, and 41), a cutting blade or edge that separates the film drawn from the roll into separate individual sheets (46), and a base member (portion of generally planar top 17) between the roll and the cutting edge. (Figures 1-4 and 7.) Garr further teaches that the assembly may be used with rolls of different widths and that "[t]he object to be wrapped can be placed either on or below the film on the upper surface of the

³ Our interpretation is consistent with the description found in the present specification, which states (p. 18, ll. 19-23): "The overall size of the dispenser is inconsequential, so long as the material made available in the platform area is sufficiently large enough to receive at least one of a user's hands, which will be on the order of 10 inches to a foot square, or thereabouts." That is, the recited minimum defined area of "at least 40 square inches" appears to be significantly less than the median size of an adult human hand.

table, then wrapped on the table top." (Column 1, lines 39-41; column 4, lines 30-33.)

Thus, Garr's dispenser differs from the invention recited in appealed claim 1 only in terms of the recited area or size of the base member. That is, Garr does not specifically disclose the size of the portion of the generally planar top (17) between the roll (11) and the cutting blade 46.

As we discussed above, however, Garr teaches that the dispenser may be used with rolls of varying lengths and that the rolls may be used to wrap food products on the top of the wrapping table assembly. For food products larger than the size of an "average adult human hand," one of ordinary skill in the art would have found it prima facie obvious to maximize the surface area of the top of Garr's wrapping table assembly, thus arriving at a dispenser encompassed by appealed claim 1, in order to facilitate the food wrapping process.

We do not have to discuss Stoller because it is not necessary to support the examiner's rejection of appealed claim 1.

The appellant argues that Garr "is not directed to dispensing film with an adhesive on one surface or to dispensing film to be placed on the hand of an adult user." (Second appeal brief, page 4.) This argument fails because appealed claim 1 is

directed to a dispenser, not to a method of covering the palm of an adult human hand, as the appellant would apparently have us believe. As pointed out by the examiner (answer, page 4), the absence in the prior art of a disclosure related to function does not preclude a finding of unpatentability where the structural limitations of the claimed product are otherwise disclosed or suggested in the prior art. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (holding that a statement of intended use in a claim fails to distinguish over the prior art apparatus); In re Wolfe, 251 F.2d 854, 855, 116 USPQ 443, 444 (CCPA 1958) ("The characterization of a massage device for 'dental' use, as distinguished from use on other parts of the body, is not a patentable distinction since in the apparatus claims before us it points to no structural difference."); In re Hack, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) (explaining that the grant of a patent on a composition or machine cannot be predicated on a new use of that composition or machine).

The appellant contends that the relied upon prior art references do not disclose or suggest a solution to the problem described in the present application. (Second appeal brief, page 4.) This argument is also unpersuasive. Although the reason or motivation provided in the prior art is not the same

as that of the applicant, this does not in and of itself preclude a conclusion of obviousness. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc).

The appellant argues: "Neither reference provides a space for the palm of a hand to contact the sheeted material. Garr provides only a very small area that may be considered some type of base, although this area is certainly not designed, configured or sized for the purpose of the present invention." (Second appeal brief, page 5.) As we discussed above, Garr provides a suggestion to size the portion of the table top (i.e., an area corresponding to the appellant's base member) so as to arrive at the appellant's claimed invention, albeit for a reason that is different from that of the appellant. When relatively large food products are wrapped using Garr's assembly, Garr's table top area corresponding to the appellant's base member would be greater than 40 square inches and would be capable of accommodating the palmar surface of an adult human hand. In re Wolfe, 251 F.2d at 856, 116 USPQ at 444-45 (CCPA 1958) ("[W]e see nothing patentable in making the roller small enough and of an appropriate material for oral use. The differences are mere change of size and substitution of material

of the most obvious kind, on a par with the differences between a hairbrush and a toothbrush.").

We have also considered the arguments set forth in the reply brief filed Feb. 22, 2002 (paper 19), but do not find them persuasive of any reversible error in the examiner's rejection of appealed claim 1.

In summary, we affirm the examiner's rejections under: (i) 35 U.S.C. § 112, ¶2, of appealed claims 3 and 8 as indefinite; and (ii) 35 U.S.C. § 103(a) of appealed claims 1 through 3, 5, 6, and 8 as unpatentable over Garr in view of Stoller.

The decision of the examiner is affirmed.

Appeal No. 2002-1123
Application No. 09/110,987

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Catherine Sun

Catherine Timm
Administrative Patent Judge

Norman H. Deane

Romulo H. Delmendo
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

INTERFERENCES

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